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09/975.443**C. REMARKS**

Claims 1, 2, 4, and 6-9 are amended. Amendments to these claims are fully supported by the original specification (e.g., Applicants' specification Page 5, Lines 12-25), and no new matter has been introduced.

Defective Oath/Declaration

The original Declaration of Karmal Chandrakant Patel was included with the present application when the application was filed on 10/11/2001.

A copy of the original signed and submitted Declaration of Karmal Chandrakant Patel, signed on October 9, 2001, is attached and incorporated in Applicants' response. In order to assist the Examiner, copies of the original Declarations signed by each inventor, together with a copy of the stamped received Certificate of Mailing is included.

Claim Rejections – 35 U.S.C. § 102(e)

Claims 1, 2 and 6-9 stand rejected under 35 U.S.C. §102(e) as being anticipated by Kuppusamy et al., U.S. Patent No. 6,769,096. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed Cir. 1987).

Furthermore the reference must be an enabling disclosure of each and every element as set forth in the claim. *In re Hoecksmas*, 158 USPQ 596, 600 (CCPA 1968); *In re LeGrive*, 133 USPQ 365, 372 (CCPA 1962). Because the Examiner does not show that Kuppusamy teaches or suggests each an every element of the amended claims 1, 2, and 6-9 or enables each and every element of

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these claims, these claims are not anticipated, the rejection should be withdrawn, and the claims should be allowed.

As will shown below, Kuppusamy does not teach or suggests a method, computer system, or computer program for displaying document components in a scrollable long documents as claimed in the present application. Amended claims 1, 2 and 6-9 are therefore patentable and should be allowed. Applicants respectfully traverse each rejection individually, and requests reconsideration of amended claims 1, 2, and 6-9.

Claim 1

Concerning Examiner's rejection of claim 1, Applicants respectfully submit that Kuppusamy does not anticipate the invention of Applicants claim 1 because Kuppusamy does not teach expressly or inherently the elements of amended claim 1 or enable the elements of amended claim 1. Specifically, Kuppusamy does not teach or suggest the claimed elements of "in response to retrieving the document, parsing the document for tags identifying document components" and "in response to parsing the document, creating a list of identified document components, and storing the list in a cache".

Examiner's rejection of Applicants claim 1 stated that "parsing the document for tags identifying headings" and that "Kuppusamy discloses this limitation in that, anytime an HTML document is loaded into a browser, the browser parses every tag in the document" and that "Kuppusamy discloses this limitation in that the document is scanned to identify headings".

Applicants respectfully traverse Examiner's rejection as follows:

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Kuppusamy teaches in FIG. 3 “a screen display 215 having a frameset 218 that is created in response to a TOC creation event. In particular, the word processing program 37, in response to the user's input, creates a TOC document 220 and a frameset 218 containing the target document 202 and the TOC document 220.” (Col 6, Lines 56-65). Thus, Kuppusamy teaches that the TOC document is created in response to “the user's input”, and in particular in response to a “TOC creation event” and not “in response to retrieving the document, parsing the document for tags identifying document components” as claimed in the present invention.

Furthermore, Kuppusamy teaches that “in response to inserting the TOC field into the TOC document at block 708, the AA branch is followed to block 710 (FIG. 7B).

Turning now to FIG. 7B, the TOC field, at block 710, performs the task of scanning the target document to identify the headings.” (Col 12, Lines 6-11). Thus, Kuppusamy teaches that the scanning of the target document to identify headings is in response to inserting the TOC field into the TOC document, and does not teach the claimed element “in response to retrieving the document, parsing the document for tags identifying document components”.

In the teaching by Kuppusamy “the second field inserted in the TOC document 230 is a TOC field. When instantiated, the TOC field 230 performs several tasks. First, the TOC field 230 scans the target document 202 (identified by the pointer set by the RD field 224) to identify the headings of the target document 202” (Col 7, Lines 50-55). Thus, Kuppusamy teaches that when the TOC field is instantiated, the TOC field scans the target document to identify the headings of the target document, and does not teach the claimed element “in response to retrieving the document, parsing the document for tags identifying document components”.

Therefore, the method claim element “in response to retrieving the document, parsing the document for tags identifying document components” as claimed in the present invention is not taught nor suggested by Kuppusamy.

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Thus, in light of the above claim element not anticipated by Kuppusamy, Applicants respectfully request allowance of claim 1.

Kuppusamy teaches "at 604, an entry is created in the TOC document" (Col. 10, Line 44) and "at 602, a frameset and the TOC document are created" (Col. 10, Lines 35-36), and that "once the frameset is created, the contents of both documents can be saved as HTML documents in an Internet browser-readable format" (Col 10, Lines 8-10), and that "saving documents in HTML language is known in the art of word processors." Thus, Kuppusamy teaches that the contents in the TOC document are stored using conventional document saving techniques, and Kuppusamy does not teach storing the entries in a cache as in the claimed element "in response to parsing the document, creating a list of identified document components, and storing the list in a cache".

In contrast, the Applicants' disclosure teaches "in response to parsing the document, creating a list of identified document components, and storing the list in a cache" wherein the results of the parsing (i.e., the list of headings, hyperlinks, image descriptions, or other document components) are stored in a cache and not as conventional HTML documents.

Furthermore, Kuppusamy teaches that the integrity of the original document is not preserved wherein "as part of creating the hyperlink entry, an anchor is inserted into the target document at a location proximate to the preselected heading" (emphasis added) (Col 3, lines 19-22). Thus, the original long document is modified via the teaching by Kuppusamy. In contrast, the subject document of the elements in the Applicants' claim 1 is the instant "long document from a server" as claimed in claim 1, and not the document that is modified by having an "anchor [that] is inserted into the target document" as taught by Kuppusamy.

Furthermore, Kuppusamy teaches "an anchor is inserted into the target document" (Col 3, Line 20) wherein a frameset contains "a target document in a second frame" (Col 3, Line 12), and "once the frameset is created, the contents of both documents can be saved as HTML documents"

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Thus, Kuppusamy teaches that the contents in the updated target document are stored using conventional document saving techniques, and Kuppusamy does not teach storing the entries in a cache as in the claimed element "in response to parsing the document, creating a list of identified document components, and storing the list in a cache".

Thus, in light of the above, the claim elements are not taught or suggested by Kuppusamy, Applicants respectfully request allowance of claim 1.

Independent claims 6 and 8 are not taught or suggested by Kuppusamy for similar reasons as discussed above with respect to claim 1.

Dependent claims 2-5, 7, and 9 depend from claim 1, 6 or 8, and thus are not taught or suggested by Kuppusamy for similar reasons as discussed above.

Claim Rejections – 35 U.S.C. § 103

Claims 3-5

Claims 3 and 5 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Kuppusamy, in view of Amro et al., U.S. Patent No. 5,757,370. Applicants respectfully traverse each rejection. To establish a prima facie case of obviousness, three basic criteria must be met.¹ First, the combination must teach or suggest all of Applicants' claim limitations.² Second, there must be a

¹ Manual of Patent Examining Procedure §2142.

² *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974).

suggestion or motivation to combine the references.³ Finally, there must be a reasonable expectation of success in the combination.⁴

Claims 3 and 5 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Kuppusamy, in view of Amro et al., U.S. Patent No. 5,757,370. Applicants respectfully submit that neither Kuppusamy nor Amro, either alone or in combination, teaches or suggests a method, system, or computer program for displaying document components in a scrollable long document as claimed in the present application.

Responsive to Examiner's rejection of claims 3-5, claims 3-5 are dependent from independent claim 1. In particular, Applicants' response with respect to claim 1 above demonstrates that independent claim 1 should be allowed.

Thus, the combination of Kuppusamy and Amro does not teach or suggest all of Applicants' claim limitations, in light of the response above concerning the elements of independent claim 1 from which dependent claims 3-5 depend.

Also, in light of the response above concerning the elements of independent claim 1 from which dependent claims 3-5 depend, there is no suggestion or motivation to combine the teachings of Kuppusamy and Amro.

Furthermore, in light of the response above concerning the elements of independent claim 1 from which dependent claims 3-5 depend, there is no reasonable expectation of success in the combination of Kuppusamy and Amro.

³ *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991).

⁴ *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986).

Therefore, Applicants respectfully submit that dependent claims 3-5 are not obvious over Kuppusamy, in view of Amro and respectfully request allowance of dependent claims 3-5.

Claim 4

Claim 4 stands rejected under 35 U.S.C 103(a) as being unpatentable over Kuppusamy, in view of Sotomayor, U.S. Patent No. 5,708,825. As will be shown below, neither Kuppusamy nor Sotomayor, either alone or in combination, teaches or suggests a method, computer system, or computer program displaying document components in a scrollable long documents as claimed in the present application. Amended claim 4 is therefore patentable and should be allowed. Applicants respectfully traverse each rejection individually, and requests reconsideration also of claim 4.

Responsive to Examiner's rejection of claim 4, claim 4 is dependent from independent claim 1. In particular, Applicants' response with respect to claim 1 above demonstrates that independent claim 1 should be allowed.

Thus, the combination of Kuppusamy and Sotomayor does not teach or suggest all of Applicants' claim limitations, in light of the response above concerning the elements of independent claim 1 from which dependent claim 4 depends.

Also, in light of the response above concerning the elements of independent claim 1 from which dependent claim 4 depends, there is no suggestion or motivation to combine the teachings of Kuppusamy and Sotomayor.

Furthermore, in light of the response above concerning the elements of independent claim 1 from which dependent claim 4 depends, there is no reasonable expectation of success in the combination of Kuppusamy and Sotomayor.

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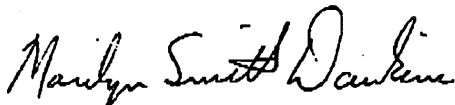
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Therefore, Applicants respectfully submit that dependent claim 4 is not obvious over Kuppusamy, in view of Sotomayor and respectfully request allowance of dependent claim 4.

Conclusion

In light of the above responses and remarks, the rejection of claims 1-9 should therefore be withdrawn, and the claims should be allowed. Reconsideration of claims 1-9 in light of the present amendments and remarks is respectfully requested. If the Examiner feels that the pending claims could be allowed with minor changes, the Examiner is invited to telephone the undersigned to discuss an Examiner's Amendment. Further, Applicants requests a telephone conference with the Examiner at the Examiner's earliest convenience.

Respectfully submitted,



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